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UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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Jacobson Holman PLLC  
400 Seventh Street, NW  
Washington, DC 20004-2201

In re Application of  
HARTMANN, Marcus et al.  
Application No.: 09/914,870  
PCT No.: PCT/EP00/01853  
Int. Filing Date: 03 March 2000  
Priority Date: 04 March 1999  
Attorney Docket No.: P67083US0

For:  $\beta$ -HEXOSAMINIDASE AND A DNA  
SEQUENCE CODING IT OBTAINED  
FROM CILIATES AND USE THEREOF

DECISION ON

REQUEST

UNDER 37 CFR 1.497(d)

This decision is in response to "Response to Notification of Defective Response," filed on 14 June 2002, in effect asking that the Office vacate the Notification of Defective Response.

#### **BACKGROUND**

On 03 March 2000, applicants filed international application PCT/EP00/01853. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 September 2000. The deadline for entry into the national stage in the United States was thirty months from the priority date, or 04 September 2001.

On 04 September 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 28 August 2001, the Office mailed NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 28 January 2002, applicants filed a response to the Notification of Missing Requirements.

On 14 May 2002, the Office mailed NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the declaration did not comply with 37 CFR 1.497(a)-(b).

On 14 June 2002, applicants filed the instant request.

On 12 December 2002 and 13 December 2002, applicants filed a petition under 37 CFR 1.181 accompanied by a postcard and papers claimed to have been filed with the Office on 28 January 2002.

## DISCUSSION

### PETITION UNDER 37 CFR 1.181

MPEP at section 503 states, in part:

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

The postcard receipt lists, *inter alia*, "Amdt., Response to Office Action, Petition for XOT, Sequence Listing, and Other: Not. of Missing Rqts and Computer Diskette." The Office is in receipt of the itemized contents. However, the Office is not in receipt of the consent of the assignee and it is not listed on the postcard receipt.

The postcard receipt does not evidence that a consent from the assignee was received on 28 January 2002. The paperwork has a receipt date of 12 December 2002.

### REQUEST UNDER 37 CFR 1.497(d)

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1) and (2) have been met. Applicants have provided a statement from Peter Vohle stating that the error in inventorship occurred without deceptive intention on his part.

Item (3) has not been met. The consent of the assignee is not signed by someone with apparent authority to bind the corporation and does not certify that the signors have authority to bind the corporation. In addition, the assignment fails to identify the present application, as required by 37 CFR 3.21.

## CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

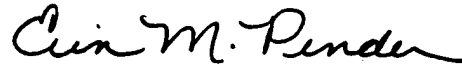
The request under 37 CFR 1.497(d) is **REFUSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



Boris Milef  
PCT Legal Examiner  
PCT Legal Administration



Erin M. Pender  
Attorney Advisor  
PCT Legal Administration

Telephone: (703) 305-0455  
Facsimile: (703) 308-6459